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10/581,057	05/30/2006	Takahiro Takemoto	2006_0759A	7095
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EXAMINER				
MARANDI, JAMES R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,057

Applicant(s)

TAKEMOTO, TAKAHIRO

Examiner

JAMES R. MARANDI

Art Unit

4157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 5/30/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "system & Method for video Ad Insertion".

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

"Program", as recited, is Functional Descriptive Material (FDM).

"Functional Descriptive Material" consists of data structures and computer programs which impart functionality when employed as a computer component. The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." (The New IEEE Standard Dictionary of Electrical

and Electronics Terms 308 (5th ed. 1993)). When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). However, claim 12 as recited provides no physical medium to contain the program (i.e. ROM) enabling it to be operated on through the CPU and therefore produce a tangible and/or transformative result. **See MPEP 2106.01 (I).**

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by D.J. Zigmond, WIPO International publication WO 99/66719 (hereinafter "Zigmond").

Regarding claim 1, Zigmond discloses:

A reception device for receiving a broadcast wave (Figure 5, element 90), selecting any of a commercial stream (Figure 5, elements 84, and 86) and a program stream (Figure 5, "Programming Delivery") that are modulated in the broadcast wave (Figure 5, "Programming Delivery"), and outputting the selected stream (Figure 5, element 58), comprising: an acceptance unit (Figure 1, element 15) operable to accept a channel operation by a user (Figure 5, element 88); and a switch unit operable to, when the acceptance unit accepts the channel operation, select the commercial stream before the program stream (Figure 5, elements 88, 83, 86, and 90), as the stream to be output (Figure 5, element 58). (Abstract; Page 14, lines 18-31; Page 15, lines 1-7; Figure 6)

Regarding claim 2, **further comprising a first judgment unit (Figure 5, elements 88, and 90) operable to judge whether an end time of one of a plurality of commercials which are included in the commercial stream has come, the commercial stream also including time information showing an end time of each of the plurality of commercials, wherein the switch unit switches from the commercial stream to the program stream when the first judgment unit judges that the end time of the commercial has come. (Page 6, lines 6-16)**

Regarding claim 3, **further comprising a second judgment unit** (Figure 5, elements 88, and 90) **operable to judge whether an end time of one of a plurality of program segments which are included in the program stream has come, the program stream also including time information showing an end time of each of the plurality of program segments, wherein the switch unit switches from the program stream back to the commercial stream when the second judgment unit judges that the end time of the program segment has come.** (Page 6, lines 6-16) Though the applicant claims 1st and second judgment units, it should be noted that there are no explanations offered as to why such functionalities should be physically separate. Furthermore Zigmond's disclosure's elements 88 and 90 fully meet the logical functionalities as stated.

Regarding claim 4, **wherein the switch unit repeatedly switches from the commercial stream to the program stream and back to the commercial stream, so long as a predetermined condition is met.** (Figure 6; notice the potential repetitive operation between elements 112, 114; 114, 116; and 122, 110. "Predetermined condition" will be the trigger event expected by element 114, and is further elaborated upon in page 22, lines 19-23)

Regarding claim 5, **further comprising a measurement unit operable to measure a total time during which the commercial stream is selected, wherein the predetermined condition is that the total time is below a required commercial viewing time.** (Zigmond's teaching, through the combination of Figure 5 elements 88, 83, and 90, allows for monitoring of the time the commercial being viewed, as reflected in Page 18, lines 26- 31; Page 19, lines 1-6, to trigger various actions/ operations as claimed.)

Regarding claim 6, **further comprising a third judgment unit** (Figure 5,elements 83, 88, and 90) **operable to judge whether the acceptance unit accepts a commercial viewing operation by the user before the end time of the program segment, wherein when the third judgment unit judges that the acceptance unit accepts the commercial viewing operation before the end time of the program segment, the switch unit switches from the program stream back to the commercial stream without waiting for the end time of the program segment.**
(Page 18, lines 26- 31; Page 19, lines 1-6)

Regarding claim 7, **further comprising a display unit** (Figure 8, element 58) **operable to display a character string** (Figure 8, element 148)

indicating one of the plurality of commercials that corresponds to a current time, wherein the acceptance unit accepts the commercial viewing operation of requesting to view the commercial indicated by the displayed character string. (Page 26, lines 23-31; Page 27, lines 1-27)

Regarding claim 8, **wherein a synopsis stream is modulated in the broadcast wave together with the commercial stream and the program stream, and the switch unit selects the synopsis stream after the commercial stream and before the program stream, for a predetermined time period.** The synopsis could be included as part of the programming database 140 (Page 6, lines 28-30), and can be retrieved/ displayed per element 148 in Figure 8, and as explained in page 27, lines 24-27.

Regarding Claim 9, **wherein the synopsis stream includes a plurality of synopses, and the switch unit selects the synopsis stream to output one of the plurality of synopses that corresponds to a current time.** (Rejected by the same analysis as claim 8)

Regarding claim 10, **further comprising a composite unit operable to, when the switch unit switches from the program stream back to the**

commercial stream, display a composite image in which an image of the commercial indicated by the displayed character string is scaled down and superimposed on an image of the program segment (Page 27, lines 24-27).

Regarding claim 11, **wherein each of the program stream and the commercial stream includes a bonus image at an end portion, and any of the program stream and the commercial stream includes information showing a selection criterion for each bonus image, the reception device further comprises: a measurement unit operable to measure a total time during which one of the program stream and the commercial stream is selected; and an output unit operable to, when a current time reaches the end portion of the program stream, output a bonus image corresponding to a selection criterion that is satisfied by the total time measured by the measurement unit;** Zigmond offers collection of data as to viewing habits of the viewer (Figure 5, element 82; Page 14, lines 24-31; Page 15, lines 1-19. This data could very well be the times and durations of what the viewer watches and in turn can feed into Ad Selection Criteria element 83. As indicated in Page 26, lines 20-22 (Figure 4), the insertion process could be for a variety of content which covers any content classified as "Bonus".

6. Claim 12, computer-readable program operationalizing the device of claims 1-11 is hereby rejected by the same analysis.

7.

Claim 13, the method operationalizing the device of claims 1-11 is hereby rejected by the same analysis.

8. Claim 14, a system effectuating the methods of claims 1-11 is hereby rejected by the same analysis.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES R. MARANDI whose telephone number is (571)270-1843. The examiner can normally be reached on 8:00 AM- 5:00 PM M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James R. Marandi/
Patent Examiner

/Vu Le/
Supervisory Patent Examiner, Art Unit 4157